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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,086	07/22/2005	Leopold Murhammer	449122082300	5609
25227	7590	07/11/2006	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			BRANDT, CHRISTOPHER M	
			ART UNIT	PAPER NUMBER
			2631	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/543,086

Applicant(s)

MURHAMMER ET AL.

Examiner

Christopher M. Brandt

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement submitted October on 12, 2005 have been considered by the Examiner and made of record in the application file.

Claim Objections

Claims **2 and 3** are objected to because of the following informalities:

Consider **claim 2**. Replace “a” on **line 3** with “an”. Appropriate correction is required.

Consider **claim 3**. Replace “e--mail” on **line 3** with “e-mail”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-2, 5-11** are rejected under 35 U.S.C. 102(b) as being anticipated by **Eloranta (WO 01/60098 A1)**.

Consider **claim 1**. Eloranta clearly shows and discloses a method for monitoring (intercepting) the communications of a certain equipment or person, wherein for an identification information (preferably MSISDN, IMEI, IMSI) relating to at least one mobile station 1 (figure 1)

a check is made for a matching entry of identification information, which is stored in database 5 (figure 1) with interception to be based on any of the parameters stored in the database 5 (page 5 line 27 - page 6 line 19, page 7 lines 26-37, read as method for deciding whether to intercept a telecommunications connection wherein, for an identification detail relating to at least one subscriber of the telecommunications connection, a check is made as to whether this identification detail is included in at least one identification detail abbreviation relating to the subscriber to be monitored which is stored in a list, with interception of the telecommunications connection being initiated if it is stored in the list).

Consider **claim 2** and **as applied to claim 1**. Eloranta discloses a method wherein the identification information can relate to a MSISDN (mobile subscriber ISDN number) (page 6 line 28 – page 7 line 8, read as method wherein the identification detail abbreviation is part of a identification detail relating to a mobile subscriber number).

Consider **claim 5** and **as applied to claim 1**. Eloranta clearly discloses a method wherein an identification information can be part of an IMEI (page 7 lines 10-37, read as method wherein an identification detail abbreviation is part of a telecommunications terminal identification (IMEI)).

Consider **claim 6**. Eloranta discloses a method wherein the communicating network connection can be a mobile and / or a fixed communication and / or other networks such as the internet (page 5 lines 10-25, read as method wherein the telecommunications connection is routed over a mobile radio network and / or fixed network and / or the Internet).

Consider **claim 7** and **as applied to claim 1**. Eloranta clearly discloses a method wherein the interception is based on identification information that is stored in the database 5 (figure 1)

and sent to the legal interception gateway (LIG) 3 (figure 1) (page 6 lines 8-19, read as method wherein the checking is undertaken by equipment of a telecommunications network over which the telecommunications connection is routed or by equipment connected to it).

Consider **claim 8** and **as applied to claim 1**. Eloranta discloses a method wherein the monitoring (intercepting) is undertaken by the law enforcement agency / legal interception gateway (LIG) 3 (figure 1) (page 5 line 27 – page 6 line 6, read as method wherein the interception is undertaken by official equipment).

Consider **claim 9** and **as applied to claim 1**. Eloranta discloses a method wherein the identification information is checked each time a new connection is activated (page 6 lines 8-19, read as method wherein identification details are checked when a connection is set up).

Consider **claim 10** and **as applied to claim 1**. Eloranta discloses that the invention is applicable to pure packet switching (page 5 lines 10-25, read as method wherein identification details of telecommunications subscribers are checked on transmission of data packets over a telecommunications connection (6)).

Consider **claim 11**. Eloranta clearly shows and discloses a legal interception gateway (LIG) 3 (figure 1) to monitor (intercept) communication connections, with an identifier data relating to a mobile station (figure 1) to be monitored (intercepted) stored in a database 5 (figure 1), with matching entry means in the database 5 for identification information cooperates over a communication connection relating to a mobile station 1 with stored identification information, with the legal interception gateway (LIG) 3 to initiate the interception to be based on any of the parameters stored in the database 5 (page 5 line 27 – page 6 line 19, read as device (8, 9) for deciding whether to intercept telecommunications connections, with a list of identification detail

abbreviations relating to telecommunications subscribers to be intercepted stored in a memory, with comparison equipment for comparing identification details transferred over a telecommunications connection relating to subscribers of the telecommunications connection with stored identification detail abbreviations, with decision equipment to initiate the monitoring of a telecommunications connection with at least one telecommunications subscriber identified as to be monitored by an identification detail abbreviation).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eloranta (WO 01/60098 A1)** in view of **Vogel et al. (US PG PUB 2005/0054300 A1)**.

Consider **claim 3** and as **applied to one of the previous claims**. Eloranta discloses the claimed invention except a method wherein an identification detail abbreviation is part of an e-mail address of a telecommunications subscriber.

However, Vogel et al. clearly disclose a method wherein the specification / monitoring parameters is part of a URL including an email address of a wireless device 306 (figure 3) (paragraphs 66 ad 71, read as method wherein an identification detail abbreviation is part of an e-mail address of a telecommunications subscriber).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Vogel et al. into the method of Eloranta in order to be able to monitor (intercept) all possible transmissions of information.

Consider **claim 4** and as **applied to claim 3**. Eloranta discloses the claimed invention except a method wherein the identification detail abbreviation is a domain name or a part of a domain name in an e-mail address of a telecommunications subscriber.

However, Vogel et al. clearly disclose a method wherein the specification / monitoring parameters includes a domain name or part of a domain if an email address is one of the specifications. Note that two of the specifications mentioned are a URL including an email address and also a telephone number (paragraphs 66 and 71, read as method wherein the

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identification detail abbreviation is a domain name or a part of a domain name in an e-mail address of a telecommunications subscriber).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Vogel et al. into the method of Eloranta in order to be able to identify where the email is originating from.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

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P.O. Box 1450
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Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher M. Brandt whose telephone number is (571) 270-1098. The Examiner can normally be reached on Monday-Friday from 8:00am to 4:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Christopher M. Brandt
C.M.B./cmb

July 6, 2006

EDAN ORGAD
PATENT EXAMINER/TELECOMM.

Edan Orgad 7/6/06